

REMARKS

Claims 1 through 18 are pending in this application. The Examiner has rejected claims 1 through 5 under 35 U.S.C. §112, first paragraph. Claims 1, 2, 4, and 5 have been amended to overcome this rejection. It is now believed that all of Applicant's claims comply with the requirements of 35 U.S.C. §112, first paragraph.

The Examiner has rejected Claims 1 through 4, 6 through 8, 10, 12, 15, 17 and 18 under 35 U.S.C. §103(a) as being unpatentable over Applicant's admitted prior art in view of Yumibe, U.S. Patent No. 5,378,160. Applicant respectfully traverses this rejection.

Applicant's invention shows a disk assembly 20 being attached to a printed circuit board 10. During the attachment process, two pairs of electrical terminals are electrically connected to each other. One pair of electrical terminals are traditional type of electrical connectors while the other pair of terminals are a plurality of metallic fingers that flexibly attached to contacts located on the disk assembly. The Examiner contends that Yumibe '160 discloses the electrical contacts wherein a flexible plurality of terminals are attached to contacts on a separate printed circuit board. The Examiner equates the electrical connectors in Yumibe '160 to one of the two pairs of electrical connectors used in Applicant's invention. The Examiner turns to Applicant's admitted prior art to show that the traditional electrical connectors have already been disclosed. The Examiner then combines Yumibe '160 with Applicant's admitted prior art to arrive at Applicant's invention.

Applicant traverses the Examiner's rejection for the reason being that Applicant contends that there is no motivation to combine the reference to Yumibe '160 with the reference of Applicant's admitted prior art to arrive at Applicant's invention. There is no teaching in Yumibe '160 to use traditional connectors as was used in Applicant's invention to twice electrically connect one printed circuit board with another. In fact, Yumibe '160 teaches away from the use of such traditional connectors in conjunction with the metallic fingers and contacts. First, Yumibe '160 does not at all disclose the use of traditional connectors in the disclosure. Secondly, column 1, lines 6-27 of Yumibe '160 indicate that use of the flexible finger-like terminals pressed against contacts to electrically connect adjacent PC boards increases miniaturization and allows for more compact packaging of components and assemblies in the electronics industry. Thus, Yumibe '160 teaches away from using a traditional connector as is done in Applicant's invention. *See MPEP §2145* where it states that the prior art must be considered as a whole and it is improper to combine references where the references teach away from their combination. *See In re Grasselli*, 1713 F2d. 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

In addition to teaching away from the invention, the Examiner falls short of providing a satisfactory 35 U.S.C. §103 rejection because the Examiner is using improper hindsight reconstruction to arrive at Applicant's claims. *See, In re Fritch*, 972 F.2d. 1260, 23 USPQ 2nd 1780 (Fed. Cir. 1992) where it states "it is impermissible to use the claimed invention as an instruction manual or a template to piece together the teachings of the prior art so that the claimed invention is rendered obvious . . . This court has previously stated that 'one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention'."

See also *Interconnect Planning Corp. v. Feil*, 774 F2d. 1132, 227 USPQ 543 (Fed. Cir. 1985) where it states "it is error to reconstruct the patentee's claimed invention from the prior art by using the patentee's claim as a 'blueprint'. When prior art references requires selective combination to render obvious a subsequent invention, there must be some reason for the combination other than hindsight obtained from the invention itself. It is critical to understand the particular results achieved by the new combination." In Applicant's invention, the achieved results are the fact that two pairs of connectors are automatically connected to each other, one being traditional and one being non-traditional in order to connect a head disk assembly to a printed circuit board. Applicant claims a first connector electrically connected to a second connector when terminals of a second printed circuit board are connected to contacts on a disk assembly. The simultaneous electrical connection of a second connector of a second printed circuit board to a first connector of a disk assembly while terminals of the second printed circuit board automatically electrically connect to contacts of the disk assembly is not disclosed by the references used by the Examiner. For these reasons, Applicant respectfully traverses the Examiner's rejection.

In the Office action (Paper No. 20), page 4, the Examiner states that the motivation for combining Yumibe with Applicant's admitted prior art is space utilization. This motivation would be defeated if Applicant uses and does use the first connector and the second connector as is disclosed in Applicant's claims.

Regarding to Claim 18, the Examiner tries to rationalize the use of a four terminal connectors in Applicant's invention with the eight terminal configurations shown in Yumibe '160. The

motivation given by the Examiner was "to use the Yumibe device with the circuit board of the admitted prior art." Once again, Applicant contends that the Examiner is using improper hindsight reconstruction to reject Applicant's claims and therefore Applicant traverses this rejection.

Applicant traverses the remaining claims as being dependent on independent Claims 1, 6, and 12 as already discussed above. Applicant traverses the rejection of these claims based on the reasons stated above.

It is respectfully requested that the Examiner allow Claims 1 through 18 to pass onto issue.

No fee is incurred by this Amendment.

In view of the foregoing arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,



Robert E. Bushnell
Attorney for the Applicant
Registration No.: 27,774

1522 "K" Street N.W., Suite 300
Washington, D.C. 20005
(202) 638-5740

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